

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Malyarov et al.	Docket No.:	2008P26174 US
Application No.:	10/813,575	Examiner:	WRIGHT
Filed:	3/31/2004	Art Unit:	1797
Customer No.:	28524	Confirmation No.:	4329

For: Rotary Luminometer

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY UNDER 37 C.F.R. §1.113

Sir:

This is a reply to the final Office Action of September 10, 2008. Please enter and consider the following remarks.

Please charge any shortage in fees due in connection with the filing of this paper, including any shortage in Extension of Time fees, to Deposit Account 14.1437. Please credit any excess fees to such account.

REMARKSRegarding the Status of the Claims:

Claims 1 – 18 are pending.

Claim 18 stands withdrawn from consideration on the merits.

Regarding Election/Restrictions:

The Office action has withdrawn claim 18 from further consideration on the merits as allegedly being directed to a constructively non-elected invention. Applicants respectfully traverse the requirement for restriction between claims 1 – 17, and claim 18. 35 U.S.C. §121, states in part, “[i]f two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.” The Office action does not allege that claims 1 – 17, and claim 18 are directed to independent inventions. Instead, the Office action asserts that claims 1-17, and claim 18 are distinct because they are of different scope. However, claims are not automatically drawn to independent and distinct inventions because they have varying breadth.

According to MPEP 803, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. However, if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions. Id.

This is why, as explained in MPEP 808, every requirement to restrict has two aspects: (1) the reasons (as distinguished from a mere statement of conclusion) why each invention as claimed is either independent or distinct from the other; and (2) the reasons why there would be a serious burden on the examiner if restriction is not required. The Office action in this case has not established either aspect. First, the assertion that claim 18 includes limitations not found in claims 1 -17 does not establish that claim 18 is

directed to an invention that is either independent or distinct from the invention as claimed in claims 1 – 17. Such assertion, if true, merely establishes that claim 18 may be narrower in scope than claims 1 – 17, which situation would apply to every proper dependent claim in every patent application ever filed. Clearly, a difference in claim scope cannot establish either independence or distinctness of claimed inventions, because if it did, every dependent claim in every patent application ever filed would be restrictable from its independent claim, to the extent that a dependent claim adds limitations not present in the independent claim. This is clearly not the intent of Congress in enacting 35 U.S.C. § 121.

Second, the Office action has not established that there exists a serious burden on the examiner if restriction is not required. MPEP 808.02 explains what is required to be shown by appropriate explanation. For example, the restriction requirement must explain either how the alleged distinct inventions have separate classifications, a separate status in the art, or a different field of search. Again, the MPEP explains that a mere statement of conclusion is inadequate and does not suffice as specific reasons for insisting on restriction. Here, the Office action merely alleges and concludes, without explanation, that the inventions require a different field of search, that prior art applicable to one invention would not “likely” be applicable to another invention, and that the inventions are “likely” to raise different non-prior art issues. However, no examples of the alleged different fields of search have been provided; moreover, whether or not the same prior art would be applicable to all claims, and whether or not different non-prior art issues would be applicable to different claims, are issues that are irrelevant to the determination of whether restriction is proper.

For the foregoing reasons, the restriction requirement has not adequately established that restriction of claim 18 from claims 1 – 17 is proper in this application. Reconsideration and withdrawal of the restriction requirement are respectfully requested.

Regarding 35 U.S.C §102 Rejection:

Applicants respectfully submit that the rejection of claims 1 – 17 under 35 U.S.C §102(b) over US 5,885,529 to Babson et al. (hereinafter, “Babson”) is not proper and

should be withdrawn.

Anticipation can only be established by a single prior art reference which discloses “[t]he identical invention ... in as complete detail as is contained in the patent claim.”¹ Applicants respectfully submit that Babson does not disclose the identical invention contained in independent claim 1, which requires, a read station rotatable between an entry position and a read position.

The Office action appears to acknowledge that Babson does not disclose a read station rotatable between an entry position and a read position, because on page 3, lines 15 – 20, the Office action states Babson teaches an analyte detection station for an automated immunoassay analyzer, comprising a wash station 214, a reaction reading station which includes an oval luminometer chain 215a that rotates between an entry position (at the wash station 214) and a read position at a detector (photomultiplier tube). Even assuming, for the sake of argument, that the Office action’s characterizations of Babson are correct, the claimed invention is not anticipated as a matter of law. Again, claim 1 requires a read station rotatable between an entry position and a read position, not an element rotatable between an entry position of a wash station and a read position of a detector. Since the purported read station of Babson is not even alleged to be rotatable, the present rejection is in error and should be withdrawn.

The Office action has not established that Babson discloses a transport device as claimed. The Office action merely sets forth how chain 213b operates in accordance with the Babson disclosure, without any correlation of such operation to the requirements of the claimed invention. The Office action’s comment regarding the “comprising” language of the claims is not understood. The claims require a transport device that receives vessels from said wash station and for transporting a plurality of vessels from said wash station through a defined path, and for transferring one of said plurality of vessels from said defined path into said read station at said entry position. The “comprising” language in the preamble of the claim has no relevance to this limitation. Therefore, the conclusion of the Office action is incorrect. The claims do not encompass transporting vessels from a defined path of a transport device through a wash station into a read station, but to the contrary, require transport from a wash station to a defined path, and from that defined path into a read

¹ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

station. The Office action has not shown where the claimed limitation is found in Babson, and consequently the rejection is not sustainable.

Further, the rejection is deficient as to a showing of anticipation of the dependent claims. For example, no *prima facie* case of anticipation has been shown for claims 2 – 4, 6, 8 or 12 – 16. Favorable action is respectfully solicited in view of the above.

In Conclusion:

In view of the foregoing, the present application is respectfully submitted to be in condition for allowance. Applicants request favorable action in this matter. In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner is welcome to contact the undersigned by phone to further the discussion.

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